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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,962	04/07/2000	James Shanahan	D/99458	2107

7590

02/26/2004

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

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DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,962

Applicant(s)

SHANAHAN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: original application filed 04/07/2000; IDS filed 03/04/2003.
2. Claims 1-~~36~~³⁷ are currently pending in this application. Claims 1, 19, and 28 are independent claims.

Information Disclosure Statement

3. As application No. 09/404,174 cited in the IDS filed 11/06/2000 (paper #2) has not been considered since it is a pending application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹⁻³⁷
Claims ~~1-36~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over **Serbinis et al.** (U.S. 6,314,425 – filed 08/1999).

As to independent claim 19, Serbinis teaches a method for acquiring information pertaining to a document including information (*Abstract*), comprising:

- associating a set of document service requests with the document, wherein a document service comprises a process for using a portion of the information (*the document optionally may automatically or selectively filtered in accordance with routines appropriate for the service being performed; col.10, lines 34-50*);

- selecting a document service request from the set (*user selected filtering requested for the document; col.11, lines 46 –55*);

- initiating and managing communication with a service provider to satisfy the selected document service (*Fig.2, the scheduled date/time for delivery & Fig.8*).

Serbinis does not explicitly teach “integrating any results from the selected document service into the document.”

Serbinis, however, discloses “*The Originator may ‘package’ a document prior to uploading to the DMS system ...such ‘packing’ may be automatically ...storage of the document*” (*col.11, line 66 – col.12, line 8*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teachings of Serbinis for “integrating any results from the selected document service into the document” because it would have provided the capability for permitting multiple service providers to utilize the common document management services of a server, while presenting end-users with distinct dedicated websites.

As to dependent claim 20, Serbinis teaches the set of document service requests is selected from a group of pre-packaged document service requests (*col.11, line 66-col.12, line 7*).

As to dependent claim 21, Serbinis teaches the results from the selected document service includes a new document service request associated with the document (*col.13, lines 25-43 & col.18, lines 10-22*).

As to dependent claim 22, Serbinis teaches the document services are satisfied by a third party service provider via an Internet protocol (*col.11, lines 56-65/col.21, lines 13-18 & Fig.5*).

As to dependent claim 23, Serbinis teaches the scheduler updates the set of document service requests on a predetermined schedule (*col.17, lines 57-67*).

As to dependent claim 24, Serbinis teaches the scheduler re-initiates selected document service request on a periodic basis (*col.11, lines 36-55*).

As to dependent claim 25, Serbinis teaches the periodic basis is determined by the selected document service request (*col.4, lines 5-23*).

As to dependent claim 26, Serbinis teaches the set of document service s follow a pre-determined sequence of calls to service providers for extracting information from other documents, databases and data stores, and for searching, for other information responsive to any extracted information from the other documents, databases and data stores (*col.7, lines 10-65 & Fig.2*).

As to dependent claim 27, Serbinis teaches the pre-determined sequence of calls to service providers are satisfiable asynchronously (*col.9, lines 47-62*).

Independent claim 1 is directed to a system for performing the method of claim 19, and is similarly rejected under the same rationale.

Dependent claims 2-5 & 6-7 include the same limitations as in claims 20-23 & 33-34, and are similarly rejected under the same rationale.

As to dependent claim 8, Serbinis teaches the meta-document, the scheduler and the service providers reside at the same location (*col.12, lines 23-46*).

As to dependent claim 9, Serbinis teaches the meta-document, the scheduler and the service providers reside at different locations (*col.6, lines 18-26 & col.12, lines 22-35*).

Dependent claims 10-11 include the same limitations as in claims 26-27, and are similarly rejected under the same rationale.

As to dependent claim 12, Serbinis teaches the document and the set of document service requests are user-selectable (*col.7, lines 42-51 / col.11, lines 46-55 & col.12, lines 23-36*).

As to dependent claim 13, Serbinis teaches in addition to the scheduler, a user may select a document service request from the set and initiate and manage communication with a service provider to satisfy the selected document service (*col.11, lines 36-55/Fig.2, the scheduled date/time for delivery & Fig.8*).

As to dependent claim 14, Serbinis teaches a list of document service requests from which the set of document service requests may be selected by a user (*col.18, lines 1-9*).

As to dependent claim 15, Serbinis teaches the service provider is user-selectable (*col.7, lines 42-51 / col.11, lines 46-55 & col.12, lines 23-36*).

As to dependent claim 16, Serbinis teaches a service provider can register additional document services to the list (*col.12, lines 22-36*).

As to dependent claim 17, Serbinis teaches a list of service providers available for satisfying document services (*Abstract & Fig.8, items 167a-c*).

As to dependent claim 18, Serbinis teaches the set of document service requests associated with the document are associated using metadata (*col.12, lines 37-46*).

Independent claim 28, the rejection of independent claim 19 above is incorporated herein in full.

Dependent claims 29-34, 35-36 and 37 include the same limitations as in claims 2-7, 10-11 and 18, and are similarly rejected under the same rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Serbinis et al.	U.S Patent No. 6,584,466	issue dated: Jun. 24, 2003
Meltzer et al.	U.S Patent No. 6,226,675	issue dated: May 1, 2001
Thornton et al.	U.S Patent No. 6,240,429	issue dated: May 29, 2001

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
February 22, 2004



SANJIV SHAH
PRIMARY EXAMINER